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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,337	07/10/2003	Jennifer Samproni	036249-5006	5011

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MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER
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NOGUEROLA, ALEXANDER STEPHAN

ART UNIT	PAPER NUMBER
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1753

MAIL DATE	DELIVERY MODE
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10/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/617,337

Applicant(s)

SAMPRONI, JENNIFER

Examiner

ALEX NOGUEROLA

Art Unit

1753

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 10.13-15.20.21.  
Claim(s) rejected: 1-9, 11, 12 and 16-19.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
Alex Noguerola  
Primary Examiner  
Art Unit: 1753

Continuation of 11. does NOT place the application in condition for allowance because: Applicant reads limitations into the claims that are not present in the actual wording of the claims. It should be first noted that Claims 1-15 are directed to a membrane, not an electrode or a sensor, and No. 05-60724 does teach a chloride ion-selective electrode. Applicant states, "In contrast [to No. 05-60724], Applicant has discovered that the particular group of amine agents recited in claim 1 can function as chloride ion exchangers or chloride agents as well as a curing agent for the epoxy resin, thus eliminating the need for a separate chloride ion-selective material. See the bottom of page 6 of the After-Final Amendment of September 17, 2007 ("After-Final Amendment"), bridging to page 7. As discussed on pages 2-3 of the Final rejection, (1) the rejected claims do not exclude the membrane from having substances with chloride ion-selective properties other than those listed by Applicant, and (2) "[a] chemical composition and its properties are inseparable," so "... the properties of a mixture of polythiol epoxy resin and a polyamide epoxy resin are inherent to the mixture and exist whether these properties are mentioned by No. 05-60724 or not."

Applicant states at the top of page 7 of the After-Final amendment, "Based on a reading of No. 05-60724, a person of ordinary skill in the art would not have a reasonable expectation of success of maintaining a chloride ion-selective membrane if he were to remove the described chloride ion-selective sensing material from the electrode membrane." Again, where do Applicant's claims exclude additional chloride ion-selective sensing material from the electrode membrane? Also, whether Applicant discovered a new property of the polyamide in No. 05-60724 does not change its inherency to the disclosed polyamides.

The first full paragraph on page 7 of the After-Final Amendment overlooks the fact that No. 05-60724 discloses another reason than Applicant for providing a stoichiometric excess of the polyamide, namely to make the membrane less susceptible to interference from hydrophilic ions. In rejecting an apparatus claim the Examiner is not aware of any requirement that a modification of a prior art teaching must have the same motivation as the Applicant's motive for making a modification. What is critical is whether the resulting apparatus is the same as that claimed.

At the bottom of page 7 of the after-Final Amendment Applicant asserts, "... this combination [polythiol epoxy resin or polyamide epoxy resin combination] as described in No. 05-60724 does not provide chloride ion-selective properties to the membrane." This is an unsupported opinion that, in fact, questions the enablement of Applicant's claimed invention. How could the combination of No. 05-60724 not provide the same chloride ion-selective properties to the membrane if it is otherwise the same as that claimed? Although No. 05-60724 does use a different substance than any of those claimed as the chloride ion-selective agent, Applicant has not shown how the inherent chloride ion-selective ability of the polythiol epoxy resin or polyamide epoxy resin combination as described in No. 05-60724 is deactivated by the use of an additional substance as a chloride ion-selective agent.

On page 8 of the After-Final amendment Applicant asserts, "... the mixture of a polythiol epoxy resin and a polyamide epoxy resin is not part of the membrane [in No. 05-60724], but merely forms a matrix to support the membrane." This is a distinction that is not clear to the Examiner. Applicant is invited to explain what then is the membrane in No. 05-60724.

On page 8 of the After-Final Amendment Applicant states, "Applicant believes that it is not possible to make predictions about the properties of this matrix in respect of ion selectivity from the information provided in No. 05-60724 since it is not intended to function as an ion-selective membrane." Again, since the structure and composition of the membrane of No. 05-60724 reads on the rejected claims it should have the same properties.

On page 9 of the After-Final Amendment Applicant states, "None of these groups [amine agents in claims 1, 16, and 18] is a quarternary ammonium compound." Claims 1, 16, and 18 do not exclude an additional amine agent, such as a quarternary ammonium compound. Similarly, the fact that Ghahramani discloses a substance other than claimed as an amine agent does not exclude other substances in Ghahramani from acting as amine agents, although they may not be recognized as such yet.

With regard to the rejection of claim 18 under 35 U.S.C. 103(a) based on Craig as modified by No. 05-60724 Applicant relies on his arguments against No. 05-60724 (see pages 9-10 of the after-Final Amendment), which the Examiner has rebutted above.

With regard to the amendment to claim 19, the rejection set forth in the Office action of November 29, 2006 applies to amended claim 19.

In sum, the rejections and indications of allowability in the Office action of November 29, 2006 are maintained.